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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,557	04/17/2001	Rolf Heiland	81666	8401

23685 7590 08/28/2003

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EXAMINER
PRATT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/836,557	HEILAND, ROLF	
	Examiner	Art Unit	
	Christopher C Pratt	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. Applicant's amendments and accompanying remarks filed 6/11/03 have been entered and carefully considered. Applicant's amendment is found to overcome the 112 indefinite rejections set forth in the previous rejection. Despite this advance, the amendments are not found to patently distinguish the claims over the prior art and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-2 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsutsumi et al (5223311), as set forth in the previous rejection.

Applicant argues that Tsutsumi does not teach a protective hood for automobiles. Applicant contends that Tsutsumi only teaches the laminate to be used as wrapping or packaging material for foods and dismisses Tsutsumi's teaching to use the laminate in automotive applications as "a passing reference," "vague, and open-ended."

In response to this argument the examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136

USPQ 458, 459 (CCPA 1963). Here, it is the examiner's position that the invention of Tsutsumi is capable of being used as a hood for an automobile. The examiner notes that not only does Tsutsumi teaches the exact same structure as applicant, but Tsutsumi also teaches, multiple times, that its invention can be used in the automotive field (col. 1, lines 17-18, col. 3, lines 11-14, col. 9, line 20, and col. 21, lines 42-44). The examiner further notes that automobile hoods are often comprise metal and Tsutsumi teaches the incorporation of a metal substrate (col. 21, lines 19-20).

Applicant argues that a protective hood must have a "shape or form" that permits it to serve its purpose of protecting an automobile. The examiner notes that Tsutsumi's laminate has the same shape and form as applicant's laminate, i.e. sheet form.

Applicant argues that Tsutsumi fails to teach a butyl acrylate content of 17% because Tsutsumi only teaches a broad range encompassing 17%. The examiner notes that Tsutsumi's limited range is interpreted as a teaching that Tsutsumi discloses every percentage point within that range. Applicant bears the burden of presenting a showing that 17% represents an unexpected result such that Tsutsumi did not possess the claimed limitation.

Said rejection is maintained from the last action.

Claim Rejections - 35 USC § 103

4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsutsumi et al (5223311), as set forth in the previous rejection.

Applicant challenges the examiner's assertion that it is common and well known to thermally bond fabrics. In response the examiner directs applicant to the Handbook

of Technical Textiles (pages 143-144), Ryan et al (6506873B1), Jones et al (6046118), McCormack et al (5964742), and Andrusko (5182162).

Applicant argues that the desire to render the laminate suitable for a variety of end use applications is too vague a motivation to alter the basis weight of the fabric and the amount of coating. However, it is the examiner's position that this motivation is a significant factor in commercial applications. For example, reducing the basis weight and amount of coating would allow the material to be used in food wrapping or small packaging. Whereas, increasing the basis weight and amount of coating would provide the material with improved utility to package a substance requiring additional cushioning or protection as well as automotive applications. Therefore, simple modifications of these two properties vastly increases the commercial viability of the laminate material.

Said rejection is maintained from the last action.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher C. Pratt
August 13, 2003

CHERYL A. JUSKA
PRIMARY EXAMINER